

REMARKS

The Action requires response on every ground beyond that to the two references (Nishino '278, Brown '650 and Schmidt '698) to which the Response of January 10, 2005, is already directed. This refers to rejections of claims 3, 4, and 5-16 from combinations of art with the Schmidt patent that, alone or in combination with the other art, does not disclose or suggest the halo-pipe/hollow-plastic limitation of the claim-1 parent of claims 3 and 4 or the claim-5 parent of the other claims.

The Examiner rejected claim 3 as being unpatentable over Brown in view of Schmidt and further in view of Charboneau (US 5,55,484). However, claim 3 is dependent on claim 1. As explained in the reply filed on January 10, 2005, claim 1 is patentable over Brown in view of Schmidt and Charboneau does not remove the deficiencies in Brown and Schmidt and therefore claim 3 should also be patentable.

The Examiner further rejected claim 4 as being unpatentable over Brown in view of Schmidt and further in view of Swinbanks (US 4,171,465). However, also claim 4 should be acceptable based on the dependency on claim 1 and also Swinbanks does not remove the deficiencies of Brown and Schmidt.

The Examiner further rejected claim 5 as being unpatentable over Schmidt in view of Thomas (US 4,523,141). When substantiating the grounds for rejection the Examiner states that the layers in Schmidt are hollow and provided with wires. However, as explained in the reply filed on January 10, 2005, Schmidt does not disclose hollow layers. Further the combination of Thomas and Schmidt does not lead a person skilled in the art towards the invention according to claim 5. Therefore Schmidt and Thomas cannot bar of patentability to claim 5.

Claims 6-16 should also be acceptable because of their dependency on the patentable claim 5 and because the cited reference, Noone (US 5,383,087), does not remove the deficiencies of Schmidt and Thomas.

More specifically, claim 5 includes in Jepson or improvement form the structural limitation of its first line to "a hollow pipe." The Schmidt patent only discloses a solid cable so that, when it is combined with the pipe coating of the Thomas, et al. patent, the result is a solid pipe. A solid pipe, whatever it is, is not "a hollow pipe," as claimed. In fact, it is the opposite of that claimed, and opposites, or what the combination of references teaches away from the claimed invention, cannot be ignored.

**PRIOR ART MUST BE CONSIDERED IN ITS
ENTIRETY, INCLUDING DISCLOSURES THAT
TEACH AWAY FROM THE CLAIMS MPEP 2141.03**
(emphasis original).

If the rejection is based on the piecemeal reconstruction of claim 5 by selecting pipe-parts from the Thomas, et al. patent and other parts from the Schmidt patent, such piecemeal reconstruction is impermissible hindsight.

In order for one to defeat a meritorious patent it is not enough to pick out isolated features in earlier prior art patents, combine them in one particular way with hindsight acquired only from the patent under attack, and then say that no invention would have been involved in selecting those particular features and combining them in the particular way in which the patentee did. Eversharp, Inc., et al. v. Fisher Pen Co., Inc., et al., 132 USPQ 423,434 (N.D. Ill D.C. 1861).

The Action suggests that "... Schmidt discloses all of the structure above [claim 5] with the exception of forming the insulating layer of a foamed material which inherently would have holes." This is incorrect because, as described above, Schmidt does not disclose the hollow pipe that is claimed.

The Action suggests, "The patent to Thomas discloses that it is old and well known foam plastic materials in layers of a sleeve if certain properties are desired." While this may be so, no claimed properties are identified necessary to motivate the combination of references. There must be some motivation to combine the references three possible sources, "the nature of the problem to be solved, the teachings of the prior art, ant the knowledge of persons of ordinary skill in the art." In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998).

The Action suggests, that selecting the Thomas, et al. plastic is appropriate, "... as such would provide the benefit of having some insulative properties for heat as well as for electricity."

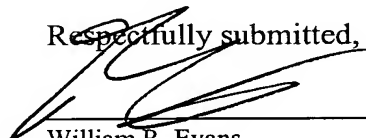
This may be, but as heat insulation is not in claim 5, the Action fails to show the motivation necessary for the combination of references.

Claims 6 to 16 depend from claim 5 for allowance therewith.

The Action is incomplete because no Thomas reference is of record, the Applicant's assumption that Thomas, et al. was intended representing the Applicant's continuing efforts to advance prosecution to allowance and, thereby, obviate the interview request still pending.

Reconsideration and allowance are, therefore, requested.

Respectfully submitted,



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